

DOCKET NO. NL 000146 (PHIL06-00146)
SERIAL NO. 09/804,002
PATENT

REMARKS

Claims 1, 3-7, and 9-20 were pending in this application.

Claims 1, 3-7, and 9-20 have been rejected.

No claims have been allowed.

Claims 1, 7, and 13 have been amended as shown above.

Claims 1, 3-7, and 9-20 remain pending in this application.

Reconsideration and full allowance of all pending claims are respectfully requested.

I. AMENDMENTS TO CLAIMS

Claims 1, 7, and 13 have been amended as shown above. In particular, Claims 1, 7, and 13 have been amended to correct several informalities noted by the Applicants. These amendments place Claims 1, 7, and 13 in better condition for allowance or appeal.

Claims 1, 7, and 13 have also been amended to recite that two display areas "extend along different borders of a third display area." Several claims already recite that the display areas extend along different borders of a third display area. For example, Claims 4, 10, and 15 recite that the display areas extend along "adjacent borders" of the third display area. As a result, the amendments to Claims 1, 7, and 13 do not require a new search.

For these reasons, the amendments to Claims 1, 7, and 13 comply with 37 C.F.R. § 1.116.

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II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,623,613 to Rowe et al. ("Rowe"). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Rowe recites a system for retrieving and displaying television program information. (*Abstract*). As shown in Figures 2-8 of *Rowe*, a display includes a category display (element 52) and a subcategory display (element 54). The displays sit next to each other along the bottom of the display.

Rowe simply recites a display for presenting television program information. *Rowe* lacks any mention of two display areas that "extend along different borders of a third display area" as recited in Claims 1 and 7. As a result, *Rowe* fails to anticipate these elements of Claims 1 and 7.

For these reasons, *Rowe* fails to anticipate the Applicants' invention as recited in Claims 1 and 7. Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1 and 7.

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III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 3-7, and 9-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,029 to Ohkura et al. ("*Ohkura*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piusecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

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motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Ohkura recites a television receiver capable of generating a display that includes a horizontal list of categories and a vertical list of channels in a selected category. (*Abstract; Figures 16-19*). A cursor (element K) identifies one of the channels in the vertical list. (*Col. 10, Lines 33-46*).

The Office Action asserts that *Ohkura* recites the use of a "connection indicator" as recited in Claims 1, 7, and 13. However, *Ohkura* simply recites the use of a cursor, which represents a box around a particular channel in the vertical list. The cursor does not "connect" an item in the horizontal list and an item in the vertical list. In particular, *Ohkura* lacks any mention of a "connection indicator" that is capable of "connecting the selected menu item of the first menu level and a menu item of the second menu level" as recited in Claims 1, 7, and 13. As a result, *Ohkura* fails to disclose, teach, or suggest these elements of Claims 1, 7, and 13.

Moreover, there is no motivation to make such a modification to *Ohkura*. As shown in Figures 16-19 of *Ohkura*, the vertical list of channels always lies below the selected category in the horizontal list. There is no need to add a "connection indicator" connecting an item in the horizontal list and an item in the vertical list because it is always clear which category is

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associated with the vertical list. Because there is no need to add a "connection indicator" to the display of *Ohkura*, one of ordinary skill in the art would not be motivated to modify *Ohkura* to reach the Applicants' invention.

For these reasons, the Office Action does not establish a *prima facie* case of obviousness against Claims 1, 7, and 13 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1, 3-7, and 9-20.

IV. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and allowance of all pending claims and that this application be passed to issue.

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SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 10-15-03


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